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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,217	09/25/2001	Kaoru Indoh	214129US0XPC	8456

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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/926,217

Applicant(s)

INDOH ET AL.

Examiner

Keith Hendricks

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-- Th MAILING DATE of this communication appears on th cover sheet with the correspond nc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*In claim 1:*

It is unclear if the "raw material mixture" contains (a) soybeans and (b) the second "raw material" of wheat and/or gluten, or simply (a) the soybeans. This confusion is, in part, due to the phrase "by the employment of a raw material mixture containing... and, raw material...".

The phrase "characterized by comprising" does not positively set forth the metes and bounds of the claimed method. It is suggested that the phrase be amended to recite "which comprises".

The phrase "comprising koji-making by the employment of a raw material..." is confusing, as it is unclear as to how this connects to the claimed "method for preparing a light-colored seasoning".

The phrase "or a similar material" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by said phrase), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

The percentages recited in claim 1 are indefinite and confusing. It is suggested that the claim be amended to clearly distinguish the starting materials and their properties. The use of soybeans "in an amount of 100-60%" refers to the total composition of "raw material mixture", while the two sub-sets of the second "raw material" component, gluten and wheat, are individually set forth as present in amounts relative to the total of their contribution. In other words, it is suggested that the claims recite the components as "a raw material mixture comprising (a) a first component comprising 0-40% soybeans ~ ~, and (b) 60-100% of gluten and wheat, wherein the gluten is present in an amount of 25-100%... the wheat is present in an amount... each relative to the total of the gluten-containing second component", or some similar language.

The claim is confusing with respect to the actual method steps employed. The phrase "by comprising koji-making by the employment of", does not clearly set forth clear, positive, active method steps, especially when, at the end of the claim, "a resultant koji product" is present. Although the art of koji-making may be well-known, it is variable, and thus the claims must set forth the steps essential to the instant process. Further, it is unclear as to how "a resultant koji product" may be made, *before* the recited

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fermentation step, as koji is a product of fermentation. This confusion may result from, at least in part, the fact that koji refers to both (a) the *Aspergillus* starter seed culture used, and (b) the method of fermenting with said culture. Clarification is required.

It is suggested that the various recited percentages be consistently represented, starting from the low-point of the range (i.e. "25-100%", not "100-25%").

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata et al. (US PAT 5,665,407, of record).

Nagata et al. discloses a process for the production of a "light-colored seasoning liquid", comprising the first step of forming a "koji-making material" of

- (a) 70-90% wheat and/or gluten, wherein the gluten is present in amounts of 25-100% by weight of the total of component (a), and wheat is present in amounts of 0-75% by weight of the total of component (a), and
- (b) 10-30% soybean.

To the material is added a koji starter seed, and salt water to give a moisture content of 35-50% (mid-col. 2). The resultant mixture is fermented for "at 10°-60°C for 3 days to 5 months" (top col. 3).

Thus, the claims are anticipated by the reference.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**